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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,416	01/22/2001	Derek J. Whiteside	10007090-1	2465

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EXAMINER	
DUNCAN, MARC M	

ART UNIT	PAPER NUMBER
2113	6

DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/767,416	WHITESIDE ET AL.	
	Examiner	Art Unit	
	Marc M Duncan	2113	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 March 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3,5-16,18,19 and 21-29* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3,5-16,18,19 and 21-29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *21 January 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

FINAL REJECTION

Status of the Claims

Claims 1, 3, 6, 7, 8, 18, 19, 21, 22, 25, 26, 27, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fawcett (077) in view of Dell.

Claims 5, 9, 10, 12, 13, 14, 15, 16 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fawcett (077) and Dell as applied to claims 1 and 19, and further in view of Arnold et al.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 3, 6, 7, 8, 18, 19, 21, 22, 25, 26, 27, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fawcett (077) in view of Dell.

Regarding claim 1:

Fawcett (077) teaches receiving an identifier from an input device in col. 2 lines 53-56.

Fawcett (077) teaches transmitting said identifier to a network location, said identifier being an attribute of a particular computing device in col. 2 lines 53-56.

Fawcett (077) teaches receiving recovery software from said network location based on said identifier, said recovery software including an installed software package in col. 2 lines 40-42.

Fawcett (077) does not explicitly teach the software package installed during manufacturing. Fawcett does, however, teach software installed on a user's computer system.

Dell teaches a software package installed during manufacturing of a computing device in the entire document.

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the installed software of Fawcett (077) with the teaching by Dell of installing software during manufacturing.

One of ordinary skill in the art at the time of invention would have been motivated to combine the teachings because Fawcett teaches that software is pre-installed on a user's computer. Dell teaches that such pre-installation occurs at manufacturing.

Regarding claim 3:

Fawcett (077) teaches the input device being a keyboard in Fig. 1.

Regarding claim 6:

Fawcett (077) teaches the network location is a web site available by way of an interface to the World Wide Web in col. 2 lines 27-29.

Regarding claim 7:

Dell teaches the software package including customized software that is not part of a standard software package installed on a model of computing device in page 1 of the document.

Regarding claim 8:

Fawcett (077) teaches receiving software that includes an updated version of the software package installed during manufacturing of said computing device in col. 2 lines 40-42.

Regarding claim 18:

The claim is rejected as being the computer program product for performing the method of claim 1.

Regarding claim 19:

The claim is rejected as being the apparatus performing the method of claim 1.

Regarding claim 21:

The claim is rejected as being the apparatus performing the method of claim 3.

Regarding claim 22:

Fawcett (077) teaches a disk drive for storing said identifier in Fig. 1.

Regarding claim 25:

The claim is rejected as being electrical signals encoded with the method of claim 1.

Regarding claim 26:

The claim is rejected as being electrical signals encoded with the method of claim 6.

Regarding claim 27:

The claim is rejected as being electrical signals encoded with the method of claim 7.

Regarding claim 28:

The claim is rejected as being electrical signals encoded with the method of claim 8.

Regarding claim 29:

The teachings of Fawcett (077) are outlined above.

Fawcett (077) further teaches receiving, by way of a server positioned at the network location, an identifier that originated at said computing device in col. 2 lines 56-68.

Fawcett (077) further teaches the server determining, based on said identifier, a software package previously installed on said computing device during manufacturing of said computing device in col. 2 lines 30-32 and lines 53-58.

Claims 5, 9, 10, 12, 13, 14, 15, 16 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fawcett (077) and Dell as applied to claims 1 and 19 above, and further in view of Arnold et al.

Regarding claims 5, 9 and 23:

The teachings of Fawcett (077) are outlined above.

Fawcett (077) does not explicitly teach an identifier being a serial number of a computing device. Fawcett (077) does, however, teach an identifier comprising access information.

Arnold explicitly teaches an identifier being a serial number of a computing device in Fig. 3.

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the serial number teaching of Arnold with the access information of Fawcett (077).

One of ordinary skill in the art at the time of invention would have been motivated to combine the teachings because Arnold teaches that the serial number is a piece of readily available relatively unique identifying information that can be used to control access rights, a need expressed by Fawcett (077).

Regarding claim 10:

Fawcett (077) teaches the network interface being an interface to the World Wide Web in col. 2 lines 27-29.

Regarding claim 12:

Dell teaches the software package including customized software that is not part of a standard software package installed on a model of computing device in page 1 of the document.

Regarding claim 13:

Fawcett (077) teaches assembling the software package previously installed on said computing device during said manufacturing in col. 2 lines 40-42.

Regarding claim 14:

Fawcett (077) teaches transmitting the software package previously installed on said computing device to said computing device by way of said network interface in col. 2 lines 40-45.

Regarding claim 15:

Fawcett (077) teaches determining if an updated version of said software package previously installed on said computing device is available in col. 2 lines 40-45.

Regarding claim 16:

Fawcett (077) teaches transmitting said updated version of said software package to said computing device in col. 2 lines 40-45.

Response to Arguments

Applicant's arguments filed 3/15/04 have been fully considered but they are not persuasive.

Regarding applicant's argument that the Dell reference does not suggest, mention or otherwise make obvious the limitation that the software package previously installed on the computing device during manufacturing, the examiner respectfully disagrees. The Dell reference states that the system is custom configured and further states that this custom configuration includes software packages. For this to be possible, the software must be installed at manufacturing and cannot "just as well be shipped in a separate box and installed by the user after the initial set up of the computer" as applicant contends.

Regarding applicant's argument that the Fawcett, Dell and Arnold combination does not teach determining or receiving the software package based on an identifier, the examiner respectfully disagrees. The Fawcett reference does teach, as applicant has noted, that the remote computer or update service does an automatic inventory or the user's computer. The examiner concedes that this process does not involve an identifier input by the user and sent to the remote computer. The examiner, however, notes the delayed download aspect of the Fawcett reference. For a delayed download to occur, the remote service uses various user-supplied identifiers to reconnect with the user's computer and download and install the appropriate software. Also inherent in this process is the use of identifiers to determine which is the appropriate software to download. When the delayed download is chosen, the update service must first determine the software on the computer during the inventory as in a normal session. The information that is obtained during the inventory must then be stored away and indexed later using the identifier to determine what software is on the computer in order to download the correct updates. Hence, the software package is determined based on the identifier. The claims, in their current form, do not specify at what point during the process the identifier is used.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc M Duncan whose telephone number is 703-305-4622. The examiner can normally be reached on M-T and TH-F 6:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Beausoliel can be reached on 703-305-9713. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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